

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. By this Amendment, Applicant has canceled claims 28-29. Thus, claims 1-27 are now pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

Claims 25-27 are objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. By this Amendment, Applicant has rewritten claims 25 and 27 in independent form. Accordingly, the Examiner is requested to remove the objection to claims 25-27.

Claims 1-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. By this Amendment, Applicant has amended the claims to improve clarity. Accordingly, the Examiner is requested to remove the § 112, second paragraph, rejection.

Claims 1-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jahn (U.S. Patent No. 6263,203) in view of Kwak (U.S. Patent Application Publication No. 2003/0039226). Applicant respectfully traverses the prior art rejection.

Independent claim 1 is directed to “[a] method of managing the changing of channels between a communications network and at least one network equipment, wherein after setting up a connection for sending or receiving data on a first channel between said network and said network equipment.” Claim 1 requires:

 sending a message, from said network controller to said network equipment, on said first channel instructing said network equipment to continue said connection on a second channel and to maintain said first channel until said network receives

data or acknowledgments of data from said network equipment on said second channel, whereupon the resources associated with said first channel are released.

Independent claim 13 and 25-27 recite limitations similar to claim 1.

Applicant respectfully submits that it is quite clear that Jahn and Kwak, alone or in combination, do not teach or suggest any of the limitations of the independent claims. In particular, it is respectfully submitted that even when the claims are given their broadest possible interpretation, the applied references, alone or in combination, do not teach or suggest sending a message, from a network controller to a network equipment, on a first channel instructing the network equipment (1) to continue a connection on a second channel and (2) to maintain the first channel until the network receives data or acknowledgments of data from the network equipment on the second channel, whereupon the resources associated with the first channel are released.

The Examiner correctly concedes that Jahn does not disclose “sending a message, from said network controller to said network equipment, on said first channel instructing said network equipment to continue said connection on a second channel” However, the Examiner asserts that because “Jahn does show in Figure 3 and the corresponding description that data is being sent from the network through B1 and B2 and then to E ..., it would have been obvious to one of ordinary skill ... to understand that V, B1, B2 and E are communicating via messages being sent back and forth and that as shown in Figure 3, a connection between both B1 and B2 is being maintained with E.”

While Applicant agrees that “V, B1, B2 and E are communicating via messages being sent back and forth” and “a connection between both B1 and B2 is being maintained with E”, there is no disclosure, teaching or suggestion in Jahn of “sending a message, from said network

controller to said network equipment, on said first channel instructing said network equipment to continue said connection on a second channel ...”, as required by the claims. Further, the Examiner’s allegation that “it would have been obvious to one of ordinary skill ... to understand that V, B1, B2 and E are communicating via messages being sent back and forth and that as shown in Figure 3, a connection between both B1 and B2 is being maintained with E” does not meet the requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, i.e., does not establish that one of ordinary skill in the art would have been motivated to modify the teachings of Jahn to include the missing claim limitation.

Moreover, simply sending data on a connection is not a suggestion to send on a first channel a message instructing the network equipment to continue the connection on a second channel. The characterization of certain limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *See In re Lalu*, (747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984)).

The Examiner also correctly concedes that Jahn does not disclose “sending a message, from said network controller to said network equipment, on said first channel instructing said network equipment to ... to maintain said first channel until said network receives data or acknowledgments of data from said network equipment on said second channel, whereupon the resources associated with said first channel are released.” However, the Examiner contends that:

Kwak teaches a method of a base station repeatedly sending a message to a mobile station and waiting for an acknowledgment message in return. See paragraphs 12 to 13. Also, Jahn teaches releasing the BI to E connection as seen in Figure 4 and its corresponding description. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to understand that data or a message/acknowledgment would be sent from E to V through B2 to confirm that E was receiving data from B2 prior to releasing B1 because without the acknowledgment or data, V would have no way of knowing whether E was in fact receiving the data on the correct channel.

The mere disclosure of sending an acknowledgement in response to receipt of packet (which is very well known in the art) and releasing a connection between a base station and mobile terminal equipment (which is also very well known in the art), does not provide any motivation for one of ordinary skill in the art to modify Jahn to “[send] a message, from said network controller to said network equipment, on said first channel instructing said network equipment to continue said connection on a second channel and to maintain said first channel until said network receives data or acknowledgments of data from said network equipment on said second channel, whereupon the resources associated with said first channel are released.”

“To support the conclusion that the claimed invention is directed to obvious subject matter, either references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference.” *Ex parte Clapp* 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). However, in the present case, the Examiner has not provided any objective reasons why one of ordinary skill in the art would have

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been motivated to modify the teachings of Jahn to include any of the features of the claimed invention which are admittedly missing from both Jahn and Kwak.

Furthermore, the Examiner has not considered the claimed invention as a whole. The Examiner has primarily applied references which the Examiner asserts implicitly teach individual features of the present invention. However, it is well settled that a claim must be read as a whole, rather than element by element. See Ball Corporation v. US, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984). The Examiner's alleged motivation for modifying/combining Jahn and Kwak is improper in that it mischaracterizes the claim limitations. That is, the claims do not require "data or a message/acknowledgment would be sent from E to V through B2 to confirm that E was receiving data from B2 prior to releasing B1" instead the claims require "sending a message ... instructing said network equipment ... to maintain said first channel until said network receives data or acknowledgments of data from said network equipment on said second channel, whereupon the resources associated with said first channel are released."

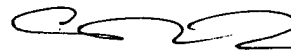
Accordingly, Applicant respectfully submits that claims 1-27 should be allowable because the cited references, alone or in combination, do not teach or suggest all of the features of the claims, and one of ordinary skill in the art would not have been motivated to combine and modify the cited references to produce the claimed invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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